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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/724,531	11/28/2000	James F. Young	10271-021-999	7010
20583	7590	10/21/2003	EXAMINER	
PENNIE AND EDMONDS 1155 AVENUE OF THE AMERICAS NEW YORK, NY 100362711			CHEN, STACY	
			ART UNIT	PAPER NUMBER
			1648	
			DATE MAILED: 10/21/2003	19

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

09/724,531

Applicant(s)

YOUNG ET AL.

Examiner

Stacy B Chen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) See Continuation Sheet is/are allowed.
- 6) ☒ Claim(s) 1,5,179,180,206 and 280-287 is/are rejected.
- 7) ☒ Claim(s) 186,198,222-224,244,245,250,258,259,262,263,276,300-302 and 304 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Continuation of Disposition of Claims: Claims pending in the application are 1,3,5,179-184,186,187,189,192,193,195,198,201,204-212,222-227,231-233,241,242,244,245,250,258-263,276 and 280-308.

Continuation of Disposition of Claims: Claims allowed are 3,181-184,187,189,192,193,195,201,204,205,207-212,225-227,231-233,241,242,260,261,288-299,303 and 305-308.

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DETAILED ACTION

1. Applicant's amendment received August 22, 2003 is acknowledged and entered. Claims 1, 3, 5, 179-184, 186, 187, 189, 192, 193, 195, 198, 201, 204-212, 222-227, 231-233, 241, 242, 244, 245, 250, 258-263, 276 and 280-308 are pending.

Claim Objections

2. Claims 281-287 are objected to for misplacement of "or" between "182" and "183".

The following claims are objected to because they recite antibodies having duplicate sequence combinations:

- 186 and 198 SEQ ID NO: #10, 18
- 222 and 258 SEQ ID NO: #10, 18, 21
- 223 and 259 SEQ ID NO: #10, 18, 22
- 224 and 250 SEQ ID NO: #10, 18, 6
- 242 and 263 SEQ ID NO: #10, 18, 22, 6
- 244 and 302 SEQ ID NO: #10, 19, 21, 22
- 245 and 304 SEQ ID NO: #10, 19, 22, 6
- 262 and 300 SEQ ID NO: #10, 18, 21, 6
- 276 and 301 SEQ ID NO: #10, 18, 21, 22, 6

Double Patenting

3. Claim 180 remains provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 55 (originally mis-numbered as claim 54) of copending Application No. 09/771,415, for reasons of record. Applicant's substantive arguments are primarily directed to the different functions of the antibodies and their non-obviousness. However, the antibodies share the same sequence, SEQ ID NO: 10 of the instant application (SEQ ID NO: 9) of the co-pending application. Further, the neutralizing activity of the co-pending application's antibody is

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a species of the immunospecific binding of the instant application's antibody. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim 180 is directed to the same invention as that of claim 55 of commonly assigned 09/771,415. The issue of priority under 35 U.S.C. 102(g) and possibly 35 U.S.C. 102(f) of this single invention must be resolved.

Since the U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP § 2302), the assignee is required to state which entity is the prior inventor of the conflicting subject matter. A terminal disclaimer has no effect in this situation since the basis for refusing more than one patent is priority of invention under 35 U.S.C. 102(f) or (g) and not an extension of monopoly.

Failure to comply with this requirement will result in a holding of abandonment of this application.

4. The provisional rejection of claims 1, 5, 179 and 280-287 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 55 of copending Application No. 09/771,415 is withdrawn in view of Applicant's amendment that removes non-elected sequences.

5. The provisional rejection of claims 1, 180, 206, 283 and 286 under 35 U.S.C. 101 as claiming the same invention as that of claims 1, 4, 15, 36 and 73 of copending Application No. 09/996,288 is withdrawn in view of Applicant's arguments.

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6. Claims 280-282 and 284-287 remain provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 73 of copending Application No. 09/996,288 in view of US Patent 5,824,307 (Johnson), for reasons of record.

Applicant's substantive arguments are primarily drawn to the assertion that the claim sets are directed to different antibodies than Johnson's: palivizumab and non-palivizumab antibodies/fragments. Claim 73 of the co-pending application is drawn to a pharmaceutical composition comprising SEQ ID NO: 48 that is not palivizumab. Claims 280-282 of the instant application are directed to antibodies other than palivizumab. Although Johnson's antibody is palivizumab, the reference teaches the practice of using a humanized RSV monoclonal antibody in a pharmaceutical composition.

Conclusion

7. Antibodies comprising SEQ ID NO: 48, 10, 18, 19, 20, 21 and 22 are free of the prior art.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stacy B Chen whose telephone number is 703-308-2361. The examiner can normally be reached on M-F (7:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James C Housel can be reached on 703-308-4027. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

SBC

Stacy B. Chen
October 10, 2003

James C Housel
10/20/03

JAMES HOUSEL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600